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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,818	06/28/2000	Jay S. Walker	00-001	5370

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WALKER DIGITAL  
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EXAMINER
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FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/605,818

Applicant(s)

WALKER ET AL.

Examiner

Mark Fadok

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 38-42 and 51-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 38-42 and 51-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 4/6/2005 which was received 7/6/2005. Acknowledgement is made to the amendment to claim 1, leaving claims 1-11,38-42 and 51-55 as pending in the instant application. The applicants amendment and remarks have been carefully considered, but were not found to be persuasive therefore the previous rejection modified as requested is presented below:

### ***USC 112 Sixth Paragraph Notification***

Applicant has provided means-plus function language in the instant claims, which could be construed as having a narrower meaning emanating from specific embodiments found in the specification. Since it is the applicant's responsibility to invoke USC 112 6<sup>th</sup> paragraph, the examiner will treat the claims using the broadest reasonable interpretation unless the applicant responds to the office action invoking USC 112 6<sup>th</sup> paragraph and identifying the exact limitations that the applicant is reading into the claims from the specification. Please be advised that should the applicant invoke USC 112 6<sup>th</sup> paragraph in response to this office action the response may still be made final using the rationale that the applicant has added new subject matter to the claims. A lack of response to this notice will be construed as prosecution history estoppel indicating that the applicant does not wish to invoke USC 112 6<sup>th</sup> paragraph.

***Examiner's Note***

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***35 USC 101 Rejection***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Nominal recitation of technology**

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow

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apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, it is not clear what feature uses the technology in a non-trivial manner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1,4,5,7,8,9,11,38,40,41,42,51,53,54 are rejected under 35**

**U.S.C. 103(a) as being unpatentable over Bruss in view of Lough.**

1,38,42,51 (CURRENTLY AMENDED) A method comprising: arranging for a customer to redeem a product from a third party (page 2, assignable contract);

Bruss teaches redeeming an assignable contract (third party) to purchase a home but does not specifically mention receiving, via an electronic communication network, information relating to a redemption, of the product and by the customer, that has occurred and determining to accept an offer based on the received information.

Lough teaches inputting sales data resultant of a redemption of a contact for sale into an electronic database (MLS) (abstract) and determining to accept an offer based on the received information (showing comparative sales information to establish a sell price for a persons home, listing price). It would have been obvious to a person having ordinary skill in the art to include in Bruss inputting the sales information for later utilization since listing agents can increase revenue by supplying accurate and timely information to the client.

**In regards to claims 4,40,53**, Bruss teaches determining, based on the received information, a third party at which an offer product may be redeemed according to the accepted offer (settlement/title company).

**In regards to claims 5,41,54**, Bruss teaches wherein the information comprises a retail price of the product during the redemption (asking price of comparable properties).

**In regards to claim 7**, Bruss teaches wherein the information comprises an amount of the product redeemed at the redemption (1 house).

**In regards to claim 8**, Bruss teaches wherein the information comprises a time of the redemption (date of sale, commonly used by agents to determine the best comparables, i.e. a sale that occurred 30 years ago would not be relevant to the current market).

**In regards to claim 9**, Bruss teaches wherein the information identifies the third party (contractor/buyer/new owner).

**In regards to claim 11**, Bruss teaches wherein the offer is an offer to purchase the product (original offer from real estate agent who then assigned the contract for redemption to the contractor, page 2, para 6).

**Claims 2,3,39 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruss in view of Lough and further in view of Official Notice.**

**In regards to claims 2,3,39,52**, the combination of Bruss and Lough teach collecting information but does not specifically state that the sequence is repeated. It would have been obvious to a person having ordinary skill in the art at the time of the invention to repeat the process, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. In re Japiski, 86 USPQ 70.

**Claims 6,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruss in view of Lough and further in view of Kerch.**

**In regards to claims 6,55**, the combination of Bruss and Lough teach the sale of homes and the acceptance of an offer, but does specifically mention calculating a difference between an offer price included in the offer and the retail price and accepting the offer if the difference is less than a threshold amount. Kerch teaches setting a threshold (page 1, price to be accepted) and a retail price to start at (market price). It would be obvious to a person having ordinary skill in the art to include in Bruss/Lough calculating the difference from a threshold and market price, because this would indicate whether or not the seller would feel comfortable selling the house at a already accepted threshold thus relieving anxiety in determining if the price is acceptable.

**Claim 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruss in view of Lough and further in view of Broshy (US 5,761,647).**



**In regards to claim 10**, the combination of Bruss/Lough teaches inputting information about the sale of a property, but does not specifically state that information is gathered concerning other products purchased during the redemption such as warranty or insurance. Broshy teaches gathering information on additional purchases made during the redemption (col 13, lines 20-40). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include information is gathered concerning other products purchased during the redemption such as warranty or insurance, since this information can provide valuable information on the total value of redemption transaction and determine if the offer should be continued at the current price.

### ***Response to Arguments***

Applicant's arguments filed 7/6/2005 have been fully considered but they are not persuasive.

The examiner has carefully considered applicant's argument concerning the prima facie case presented by the examiner and for this reason the examiner has provided art citing the features that previously covered with Official Notice.

In regards to applicant's arguments concerning the USC 101 rejection. The amendment provided by the applicant was insufficient because it is a trivia use of technology.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(571) 272-6755**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(571) 272-7159**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(571) 272-3600**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(571) 273-8300** [Official communications; including

After Final communications labeled

"Box AF"]

**(571) 273-6755** [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a long horizontal stroke extending to the right.

Mark Fadok

Primary Examiner